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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,127	07/12/2006	Charles Howard Mitch	X-16660	6482
25885	7590	01/18/2008		
ELI LILLY & COMPANY PATENT DIVISION P.O. BOX 6288 INDIANAPOLIS, IN 46206-6288			EXAMINER O'DELL, DAVID K	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 01/18/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,127	<b>Applicant(s)</b> CHAPPELL, MARK DONALD	
	<b>Examiner</b> David K. O'Dell	<b>Art Unit</b> 1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10,11,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 10,11,18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>18 October 2007, 12 July 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

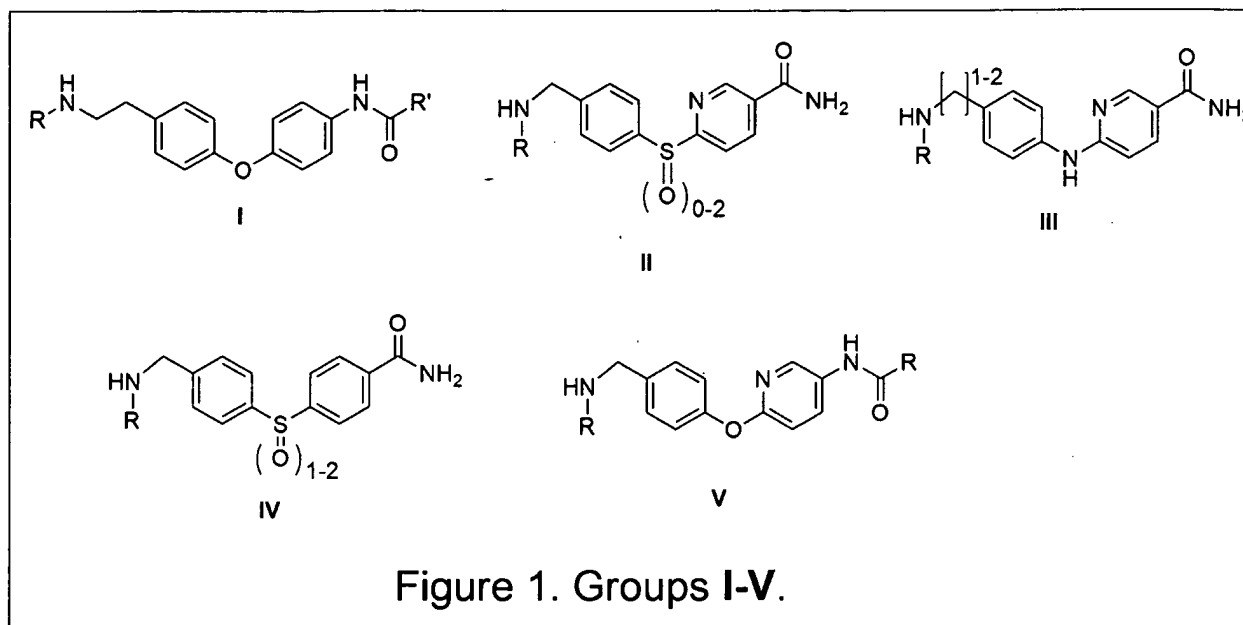
1. This application is a 371 of PCT/US05/06723 03/02/2005 which claims priority to U.S. Provisional 60/553,175 filed 03/15/2004.

### **Response to Restriction/Election**

2. Applicant's election of group I and the species N-(4-{4-[2-(3-Phenyl-propylamino)ethyl]-phenoxy}-phenyl)-acetamide (the compound of Example 29) in the reply filed on November 30, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP §818.03(a)). This requirement is made FINAL. This application contains claims drawn to a nonelected invention. A complete reply to this action must include a cancellation of nonelected claims or other appropriate action.

Under examination:

Group I, Claims 10, 11, 18, 19 drawn to compounds and compositions having a N-(4-(4-(2-(amino)ethyl)phenoxy)phenyl)amide core, shown as structure **I** in Figure 1.



### Objections

3. Claims 10, 11, 18, & 19 are objected to for being drawn to a non-elected invention.

4. Claims 10, 11, 18 & 19 are objected to for the language "in association with". It is recommended that these words be replaced with "and".

5. Claims 10, 11, 18, 19 are pending in the current application. This application is in condition for allowance except for the following formal matters:

The claims are objected to for being drawn to a non-elected invention, and superfluous language.

This application contains claims drawn to an invention nonelected without traverse in the reply filed on November 30, 2007. A complete reply to this action must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Given the large number of diverse species in the instant claims, the applicant is invited to call the

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undersigned for a complete list of compounds reading on the elected group. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

### **Conclusions**

6. No claims are allowed. The claims would be allowable if non-elected subject matter and superfluous language was removed.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David K. O'Dell whose telephone number is (571) 272-9071. The examiner can normally be reached on Mon-Fri 7:30 A.M.-5:00 P.M EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rita Desai can be reached on (571) 272-0684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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D.K.O.

*R. Desai* 1/11/08

**RITA DESAI  
PRIMARY EXAMINER**